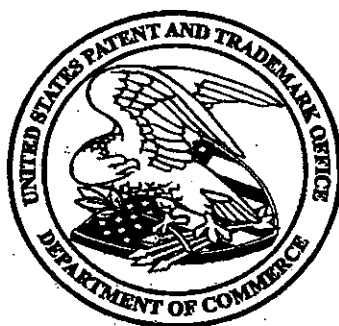


EXHIBIT C

Manual of PATENT EXAMINING PROCEDURE

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Revision 1, February 2003
Revision 2, May 2004
Revision 3, August 2005
Revision 4, October 2005
Revision 5, August 2006
Revision 6, September 2007

Chapter 700 Examination of Applications

701	Statutory Authority for Examination	706.02(h)	Rejections Under 35 U.S.C. 102(g)
702	Requisites of the Application	706.02(i)	Form Paragraphs for Use in Rejections Under 35 U.S.C. 102
702.01	Obviously Informal Cases	706.02(j)	Contents of a 35 U.S.C. 103 Rejection
703	"General Information Concerning Patents"	706.02(k)	Provisional Rejection (Obviousness) Under 35 U.S.C. *103 >Using Provisional Prior Art Under 35 U.S.C. 102(e)<
704	Search and Requirements for Information	706.02(l)	Rejections Under 35 U.S.C. 103(a) Using Prior Art Under Only 35 U.S.C. 102(e), (f), or (g)
704.01	Search	706.02(l)(1)	Rejections Under 35 U.S.C. 103(a) Using Prior Art Under 35 U.S.C. 102(e), (f), or (g); Prior Art Disqualification Under 35 U.S.C. 103(c)
704.10	Requirements for Information	706.02(l)(2)	Establishing Common Ownership or Joint Research Agreement
704.11	What Information May Be Required	706.02(l)(3)	Examination Procedure with Respect to 35 U.S.C. 103(c)
704.11(a)	Examples of Information Reasonably Required	706.02(m)	Form Paragraphs for Use in Rejections Under 35 U.S.C. 103
704.11(b)	When May a Requirement for Information Be Made	706.02(n)	Biotechnology Process Applications; 35 U.S.C. 103(b)
704.12	Replies to a Requirement for Information	706.03	Rejections Not Based on Prior Art
704.12(a)	Relationship of Requirement for Information to Duty of Disclosure	706.03(a)	Rejections Under 35 U.S.C. 101
704.12(b)	What Constitutes a Complete Reply	706.03(b)	Barred by Atomic Energy Act
704.12(c)	Treatment of an Incomplete Reply	706.03(c)	Rejections Under 35 U.S.C. 112, First Paragraph
704.13	Time Periods for Reply	706.03(d)	Rejections Under 35 U.S.C. 112, Second Paragraph
704.14	Making a Requirement for Information	706.03(k)	Duplicate Claims
704.14(a)	Format of the Requirement	706.03(m)	Nonelected Inventions
704.14(b)	Examiner's Obligation Following Applicant's Reply	706.03(o)	New Matter
704.14(c)	Petitions to Requirements Under 37 CFR 1.105	706.03(s)	Foreign Filing Without License
704.14(d)	Relationship to Information Disclosure Statements	706.03(u)	Disclaimer
705	Patentability Reports	706.03(v)	After Interference or Public Use Proceeding
705.01	Instructions re Patentability Reports	706.03(w)	<i>Res Judicata</i>
705.01(a)	Nature of P.R., Its Use and Disposal	706.03(x)	Reissue
705.01(b)	Sequence of Examination	706.04	Rejection of Previously Allowed Claims
705.01(c)	Counting and Recording P.R.s	706.05	Rejection After Allowance of Application
705.01(d)	Duplicate Prints of Drawings	706.06	Rejection of Claims Copied From Patent
705.01(e)	Limitation as to Use	706.07	Final Rejection
705.01(f)	Interviews With Applicants	706.07(a)	Final Rejection, When Proper on Second Action
706	Rejection of Claims	706.07(b)	Final Rejection, When Proper on First Action
706.01	Contrasted With Objections	706.07(c)	Final Rejection, Premature
706.02	Rejection on Prior Art	706.07(d)	Final Rejection, Withdrawal of, Premature
706.02(a)	Rejections Under 35 U.S.C. 102(a), (b), or (e); Printed Publication or Patent	706.07(e)	Withdrawal of Final Rejection, General
706.02(b)	Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or Patent	706.07(f)	Time for Reply to Final Rejection
706.02(c)	Rejections Under 35 U.S.C. 102(a) or (b); Knowledge by Others or Public Use or Sale	706.07(g)	Transitional After-Final Practice
706.02(d)	Rejections Under 35 U.S.C. 102(c)	706.07(h)	Request for Continued Examination (RCE) Practice
706.02(e)	Rejections Under 35 U.S.C. 102(d)		
706.02(f)	Rejections Under 35 U.S.C. 102(e)		
706.02(f)(1)	Examination Guidelines for Applying References Under 35 U.S.C. 102(e)		
706.02(f)(2)	Provisional Rejections Under 35 U.S.C. 102(e); Reference Is a Copending U.S. Patent Application		
706.02(g)	Rejections Under 35 U.S.C. 102(f)		

MANUAL OF PATENT EXAMINING PROCEDURE

707	Examiner's Letter or Action	710.02(b)	Shortened Statutory Period: Situations in Which Used
707.01	Primary Examiner Indicates Action for New Assistant	710.02(c)	Specified Time Limits: Situations In Which Used
707.02	Applications Up for Third Action and 5-Year Applications	710.02(d)	Difference Between Shortened Statutory Periods for Reply and Specified Time Limits
707.05	Citation of References	710.02(e)	Extension of Time
707.05(a)	Copies of Cited References	710.04	Two Periods Running
707.05(b)	Citation of Related Art and Information by Applicants	710.04(a)	Copying Patent Claims
707.05(c)	Order of Listing	710.05	Period Ending on Saturday, Sunday, or a Federal Holiday
707.05(d)	Reference Cited in Subsequent Actions	710.06	Situations When Reply Period Is Reset or Restarted
707.05(e)	Data Used in Citing References	711	Abandonment of Patent Application
707.05(f)	Effective Dates of Declassified Printed Matter	711.01	Express or Formal Abandonment
707.05(g)	Incorrect Citation of References	711.02	Failure To Take Required Action During Statutory Period
707.06	Citation of Decisions, Orders Memorandums, and Notices	711.02(a)	Insufficiency of Reply
707.07	Completeness and Clarity of Examiner's Action	711.02(b)	Special Situations Involving Abandonment
707.07(a)	Complete Action on Formal Matters	711.02(c)	Termination of Proceedings
707.07(b)	Requiring New Oath	711.03	Reconsideration of Holding of Abandonment; Revival
707.07(c)	Draftsperson's Requirement	711.03(a)	Holding Based on Insufficiency of Reply
707.07(d)	Language To Be Used In Rejecting Claims	711.03(b)	Holding Based on Failure To Reply Within Period
707.07(e)	Note All Outstanding Requirements	711.03(c)	Petitions Relating to Abandonment
707.07(f)	Answer All Material Traversed	711.03(d)	Examiner's Statement on Petition To Set Aside Examiner's Holding
707.07(g)	Piecemeal Examination	711.04	Public Access to Abandoned Applications
707.07(h)	Notify of Inaccuracies in Amendment	711.04(a)	Pulling and Forwarding Abandoned Applications
707.07(i)	Each Claim To Be Mentioned in Each Office Action	711.04(b)	Ordering of Patented and Abandoned Files
707.07(j)	State When Claims Are Allowable	711.04(c)	Notifying Applicants of Abandonment
707.07(k)	Numbering Paragraphs	711.05	Letter of Abandonment Received After Application is Allowed
707.07(l)	Comment on Examples	711.06	Abstracts, Abbreviations, and Defensive Publications
707.08	Reviewing and Initialing by Assistant Examiner	711.06(a)	Citation and Use of Abstracts, Abbreviations, and Defensive Publications as References
707.09	Signing by Primary or Other Authorized Examiner	713	Interviews
707.10	Entry	713.01	General Policy, How Conducted
707.11	Date	713.02	Interviews Prior to First Official Action
707.12	Mailing	713.03	Interview for "Sounding Out" Examiner Not Permitted
707.13	Returned Office Action	713.04	Substance of Interview Must Be Made of Record
708	Order of Examination	713.05	Interviews Prohibited or Granted, Special Situations
708.01	List of Special Cases	713.06	No Inter Partes Questions Discussed Ex Parte
708.02	Petition To Make Special	713.07	Exposure of Other Cases
708.02(a)	Accelerated Examination	713.08	Demonstration, Exhibits, Models
708.03	Examiner Tenders Resignation		
709	Suspension of Action		
709.01	Overlapping Applications by Same Applicant or Owned by Same Assignee		
710	Period for Reply		
710.01	Statutory Period		
710.01(a)	Statutory Period, How Computed		
710.02	Shortened Statutory Period and Time Limit Actions Computed		

EXAMINATION OF APPLICATIONS

713.09	Finally Rejected Application	715.01	37 CFR 1.131 Affidavits Versus 37 CFR 1.132 Affidavits
713.10	Interview Preceding Filing Amendment Under 37 CFR 1.312	715.01(a)	Reference Is a Joint Patent or Published Application to Applicant and Another
714	Amendments, Applicant's Action	715.01(b)	Reference and Application Have Common Assignee
714.01	Signatures to Amendments	715.01(c)	Reference Is Publication of Applicant's Own Invention
714.01(a)	Unsigned or Improperly Signed Amendment	715.01(d)	Activities Applied Against the Claims
714.01(c)	Signed by Attorney or Agent Not of Record	715.02	How Much of the Claimed Invention Must Be Shown, Including the General Rule as to Generic Claims
714.01(d)	Amendment Signed by Applicant but Not by Attorney or Agent of Record	715.03	Genus-Species, Practice Relative to Cases Where Predictability Is in Question
714.01(e)	Amendments Before First Office Action	715.04	Who May Make Affidavit or Declaration; Formal Requirements of Affidavits and Declarations
714.02	Must Be Fully Responsive	715.05	U.S. Patent or Application Publication Claiming Same Invention
714.03	Amendments Not Fully Responsive, Action To Be Taken	715.07	Facts and Documentary Evidence
714.03(a)	Supplemental Amendment	715.07(a)	Diligence
714.04	Claims Presented in Amendment With No Attempt To Point Out Patentable Novelty	715.07(b)	Interference Testimony Sometimes Used
714.05	Examiner Should Immediately Inspect	715.07(c)	Acts Relied Upon Must Have Been Carried Out in This Country or a NAFTA or WTO Member Country
714.06	Amendments Sent to Wrong Technology Center	715.07(d)	Disposition of Exhibits
714.07	Amendments Not in Permanent Ink	715.08	Passed Upon by Primary Examiner
714.10	Claims Added in Excess of Claims Previously Paid For	715.09	Seasonable Presentation
714.11	Amendment Filed During Interference Proceedings	715.10	Review of Affidavit or Declaration for Evidence of Prior Public Use or Sale or Failure to Disclose Best Mode
714.12	Amendments and other Replies After Final Rejection or Action	716	Affidavits or Declarations Traversing Rejections, 37 CFR 1.132
714.13	Amendments and other Replies After Final Rejection or Action, Procedure Followed	716.01	Generally Applicable Criteria
714.14	Amendments After Allowance of All Claims	716.01(a)	Objective Evidence of Nonobviousness
714.15	Amendment Received in Technology Center After Mailing of Notice of Allowance	716.01(b)	Nexus Requirement and Evidence of Nonobviousness
714.16	Amendment After Notice of Allowance, 37 CFR 1.312	716.01(c)	Probative Value of Objective Evidence
714.16(a)	Amendments Under 37 CFR 1.312, Copied Patent Claims	716.01(d)	Weighing Objective Evidence
714.16(b)	Amendments Under 37 CFR 1.312 Filed With a Motion Under 37 CFR 41.208	716.02	Allegations of Unexpected Results
714.16(c)	Amendments Under 37 CFR 1.312, Additional Claims	716.02(a)	Evidence Must Show Unexpected Results
714.16(d)	Amendments Under 37 CFR 1.312, Handling	716.02(b)	Burden on Applicant
714.16(e)	Amendments Under 37 CFR 1.312, Entry in Part	716.02(c)	Weighing Evidence of Expected and Unexpected Results
714.17	Amendment Filed After the Period for Reply Has Expired	716.02(d)	Unexpected Results Commensurate in Scope With Claimed Invention
714.18	Entry of Amendments	716.02(e)	Comparison With Closest Prior Art
714.19	List of Amendments, Entry Denied	716.02(f)	Advantages Disclosed or Inherent
714.20	List of Amendments Entered in Part	716.02(g)	Declaration or Affidavit Form
714.21	Amendments Inadvertently Entered, No Legal Effect	716.03	Commercial Success
714.25	Discourtesy of Applicant or Attorney	716.03(a)	Commercial Success Commensurate in Scope With Claimed Invention
715	Swearing Back of Reference — Affidavit or Declaration Under 37 CFR 1.131		

701

MANUAL OF PATENT EXAMINING PROCEDURE

716.03(b) Commercial Success Derived From Claimed Invention

716.04 Long-Felt Need and Failure of Others

716.05 Skepticism of Experts

716.06 Copying

716.07 Inoperability of References

716.08 Utility and Operability of Applicant's Disclosure

716.09 Sufficiency of Disclosure

716.10 Attribution

718 Affidavit or Declaration to Disqualify Commonly Owned Patent or Published Application as Prior Art, 37 CFR 1.130

719 File Wrapper

719.01 Papers in File Wrapper

719.01(a) Arrangement of Papers in File Wrapper

719.01(b) Prints

719.02 Data Entered on File Wrapper

719.02(b) Name or Residence of Inventor or Title Changed

719.03 Classification During Examination

719.04 Index of Claims

719.05 Field of Search

719.06 Foreign Filing Dates

719.07 Related Applications

720 Public Use Proceedings

720.01 Preliminary Handling

720.02 Examiner Determination of *Prima Facie* Showing

720.03 Preliminary Hearing

720.04 Public Use Proceeding Testimony

720.05 Final Decision

724 Trade Secret, Proprietary, and Protective Order Materials

724.01 Completeness of the Patent File Wrapper

724.02 Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials

724.03 Types of Trade Secret, Proprietary, and/or Protective Order Materials Submitted Under MPEP § 724.02

724.04 Office Treatment and Handling of Materials Submitted Under MPEP § 724.02

724.04(a) Materials Submitted in an Application Covered by 35 U.S.C. 122

724.04(b) Materials Submitted in Reissue Applications Open to the Public Under 37 CFR 1.11(b)

724.04(c) Materials Submitted in Reexamination File, Open to the Public Under 37 CFR 1.11(d)

724.05 Petition To Expunge Information or Copy of Papers in Application File

724.06 Handling of Petitions to Expunge Information or Copy of Papers in Application File

701 Statutory Authority for Examination

35 U.S.C. 131. Examination of application.

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

The main conditions precedent to the grant of a patent to an applicant are set forth in 35 U.S.C. 101, 102 and 103.

35 U.S.C. 101. Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Form paragraph 7.04 copies 35 U.S.C. 101. See MPEP § 706.03(a).

35 U.S.C. 100. Definitions.

When used in this title unless the context otherwise indicates -

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

(e) The term "third-party requester" means a person requesting ex parte reexamination under section 302 or *inter partes* reexamination under section 311 who is not the patent owner.

702 Requisites of the Application [R-3]

When a new application is assigned in the Technology Center, the examiner should review the contents of the application to determine if the application meets the requirements of 35 U.S.C. 111(a). Any matters affecting the filing date or abandonment of the application, such as lack of an oath or declaration, filing fee, or claims should be checked **. For Image File Wrapper (IFW) processing, see IFW Manual sections 3.1 and 3.3.

The examiner should be careful to see that the application meets all the requisites set forth in MPEP Chapter 600 both as to formal matters and as to the completeness and clarity of the disclosure. If all of the requisites are not met, applicant may be called upon

EXAMINATION OF APPLICATIONS

716.01(a)

¶ 7.66.05 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Conclusion

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Examiner Note:

This form paragraph should be presented as a conclusion to your explanation of why the affidavit or declaration under 37 CFR 1.132 is insufficient, and it must be preceded by form paragraph 7.66.

716.01 Generally Applicable Criteria [R-3]

The following criteria are applicable to all evidence traversing rejections submitted by applicants, including affidavits or declarations submitted under 37 CFR 1.132:

(A) Timeliness.

Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. *In re Rothermel*, 276 F.2d 393, 125 USPQ 328 (CCPA 1960).

Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:

- (1) prior to a final rejection,
- (2) before appeal in an application not having a final rejection,*
- (3) after final rejection **, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e); or
- (4) after the prosecution is closed (e.g., after a final rejection, after appeal, or after allowance) if applicant files the affidavit or other evidence with a request for continued examination (RCE) under 37 CFR 1.114 in a utility or plant application filed on or after June 8, 1995; or a continued prosecution application (CPA) under 37 CFR 1.53(d) in a design application.

For affidavits or declarations under 37 CFR 1.132 filed after appeal, see 37 CFR 41.33(d) and MPEP § 1206 and § 1211.03.<

(B) Consideration of evidence.

Evidence traversing rejections, when timely presented, must be considered by the examiner whenever present. All entered affidavits, declarations, and other

evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action. The extent of the commentary depends on the action taken by the examiner. Where an examiner holds that the evidence is sufficient to overcome the *prima facie* case, the comments should be consistent with the guidelines for statements of reasons for allowance. See MPEP § 1302.14. Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as "the declaration lacks technical validity" or "the evidence is not commensurate with the scope of the claims" without an explanation supporting such findings are insufficient.

716.01(a) Objective Evidence of Nonobviousness [R-2]**OBJECTIVE EVIDENCE MUST BE CONSIDERED *>WHEN TIMELY< PRESENT**

Affidavits or declarations>, when timely presented,< containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103. The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that "evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness." Such evidence might give light to circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or unobviousness, such evidence may have relevancy. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *In re Palmer*, 451 F.2d 1100, 172 USPQ 126 (CCPA 1971); *In re Fielder*, 471 F.2d 640, 176 USPQ 300 (CCPA 1973). The *Graham v. John Deere* pronouncements on the relevance of commercial success, etc. to a determination of obviousness were not negated in *Sakraida v. Ag Pro*, 425 U.S. 273, 189 USPQ 449 (1979) or *Anderson's-Black Rock Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969), where reliance was placed upon *A&P Tea Co. v. Supermarket Corp.*, 340 U.S.

716.01(b)

MANUAL OF PATENT EXAMINING PROCEDURE

147, 87 USPQ 303 (1950). See *Dann v. Johnston*, 425 U.S. 219, 226 n.4, 189 USPQ 257, 261 n. 4 (1976).

Examiners must consider comparative data in the specification which is intended to illustrate the claimed invention in reaching a conclusion with regard to the obviousness of the claims. *In re Margolis*, 785 F.2d 1029, 228 USPQ 940 (Fed. Cir. 1986). The lack of objective evidence of nonobviousness does not weigh in favor of obviousness. *Miles Labs. Inc. v. Shandon Inc.*, 997 F.2d 870, 878, 27 USPQ2d 1123, 1129 (Fed. Cir. 1993), *cert. denied*, 127 L. Ed. 232 (1994). However, where a *prima facie* case of obviousness is established, the failure to provide rebuttal evidence is dispositive.

716.01(b) Nexus Requirement and Evidence of Nonobviousness**TO BE OF PROBATIVE VALUE, ANY SECONDARY EVIDENCE MUST BE RELATED TO THE CLAIMED INVENTION (NEXUS REQUIRED)**

The weight attached to evidence of secondary considerations by the examiner will depend upon its relevance to the issue of obviousness and the amount and nature of the evidence. Note the great reliance apparently placed on this type of evidence by the Supreme Court in upholding the patent in *United States v. Adams*, 383 U.S. 39, 148 USPQ 479 (1966).

To be given substantial weight in the determination of obviousness or nonobviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore the examiner must determine whether there is a nexus between the merits of the claimed invention and the evidence of secondary considerations. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n.42, 227 USPQ 657, 673-674 n. 42 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986). The term "nexus" designates a factually and legally sufficient connection between the objective evidence of nonobviousness and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing*

Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), *cert. denied*, 488 U.S. 956 (1988).

716.01(c) Probative Value of Objective Evidence [R-2]

>

I. < TO BE OF PROBATIVE VALUE, ANY OBJECTIVE EVIDENCE SHOULD BE SUPPORTED BY ACTUAL PROOF

Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) ("It is well settled that unexpected results must be established by factual evidence." "[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant's heat shrinkable articles with those of the closest prior art, we conclude that appellant's assertions of unexpected results constitute mere argument."). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991).

>

II. < ATTORNEY ARGUMENTS CANNOT TAKE THE PLACE OF EVIDENCE

The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant.